

REMARKS

Claims 1-16, 20-41, 44-50, 52 and 54-58 were previously pending in the present application. By way of the present amendment, claims 1-14 are cancelled without prejudice as drawn to a non-elected species. Claim 16 has been cancelled. Claims 44-48 are cancelled without prejudice to their introduction in a later filed divisional application as drawn to a non-elected invention. Claims 51 and 53 have been cancelled. This leaves claims 15, 20-41, 49, 50, 52 and 54-58 pending.

The Examiner's indication of the allowability of claims 15, 20-25 and 31-36 is gratefully acknowledged. The undersigned attorney of record has noted that claims 26-30, not previously indicated as allowable because they were withdrawn, depend from allowable claim 15. Claim 15, therefore, would seem generic to claims 26-30. The allowance of these claims as depending from a generic claim is courteously requested.

CLAIM REJECTIONS - 35 USC § 112

The Examiner has rejected claims 54, 55 and 57 under 35 USC §112 first paragraph, as failing to comply with the written description requirement. The Examiner states the claim(s) contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 54 and 55 recited that the support member has a curved portion, but the specification does not provide support for a support member that has a rectangular block and a curved portion between two channels. Similarly, claim 57 discloses the apparatus as being flexible; however, the embodiment that includes the rectangular block is not disclosed as being flexible.

With regard to claim 54, the undersigned attorney of record has reviewed the portion of the specification referring to Figs. 22 and 23, and has rewritten claim 54 in independent form to properly claim an improved tubing device comprising a flexible support member having at least one, and preferably a pair, of channels formed proximate the ends of the flexible support member, as more particularly described on pages 30 and 31 of the specification. Claim 55 has been amended in view of the rewriting of claim 54 to properly claim that the structure to support the weight of the tubing apparatus comprises a curved portion of the flexible support member between the at least two channels, as shown in Fig. 22. Claim 57 has been amended to claim that the support member is semi-rigid, since claim 57 depends upon claim 49, which now claims a solid rectangular block. The solid rectangular block is described in the specification as being rigid or semi-rigid. It is believed that these amendments overcome the indefiniteness rejection, but if the Examiner believes that further changes are needed, a telephone call to the undersigned attorney of record is invited.

CLAIM REJECTIONS – 35 USC §102

The Examiner has rejected claims 37-41 under 35 USC §102(b) as being anticipated by U.S. Patent No. 6,113,039 to Riffle. The Examiner states:

“Riffle does not disclose the tubing as being used in a “medical application” or as being “intravenous” tubing, however, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.”

First, with regard to claim 37, the Examiner’s statement is inappropriate, as claim 37 is a method claim.

In general, a preamble limits the invention if it recites essential structure or steps, or if it is necessary to give life, meaning, and vitality to the claim. *Pitney Bowes Inc. v. Hewlett Packard Company*, 51 USPQ 2nd 1161 (CAFC 1999).

“If the preamble helps to determine the scope of the patent claim, then it is construed as part of the claimed invention.” *NTP, Inc. v. Research In Motion Limited*, 73 USPQ 2nd 1231 (CAFC 2004).

In this case, the preamble notes that the claimed method is for “transporting a fluid for a medical application” and recites as one of the steps “providing a piece of flexible tubing having smooth interior walls, the tubing comprising a single piece and having no adhesives on the interior surfaces”. The benefits and the requirements for this type of flexible tubing are described in the specification in conjunction with a method for transporting a fluid for a medical application. Thus, the preamble helps to determine the scope of the patent claim and gives life, meaning and vitality to the claim. Therefore, the preamble must be considered in this regard, and is not just a statement of intended use. Therefore, claim 37 is allowable over Riffle.

Claims 38-41 have been amended to clarify the invention and make it clear that this is a combination claim comprising, in combination, a support structure and a weight-bearing flexible intravenous tube. The flexible intravenous tube is a claimed element in the claim which is not shown in Riffle. Since Riffle does not show this combination of elements, claims 38-41 are allowable over Riffle.

CLAIM REJECTIONS 35 USC §103

The Examiner rejects claims 49, 50, 52, 56 and 58 as being obvious in view of U.S. Patent No. 4,922,554 to Hwang. The Examiner states that the patent to Hwang discloses a retainer for flexible drain pipe including a device having a rectangular block...and at least two

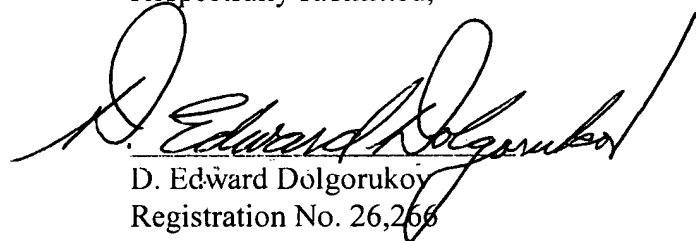
channels...to the support member for retaining tubing (A). Structure, including openings that are perpendicular to the channels, through which screws and guide plates (31 and 32) extend to support the weight of the tubing without substantially deforming the tubing retained by the support member. The two channels are substantially parallel to each other as recited in claim 50.

Claim 49 has been amended to require that the rectangular block be a "solid rectangular block". The '554 patent to Hwang would be inoperable if his rectangular block was solid. Claim 49 is thus allowable over Hwang.

Claims 50, 52, 56 and 58 are dependent claims depending on the now allowable claim 49 and thus, are also allowable.

In view of the above amendments, and the remarks explanatory thereof, a favorable reconsideration of the present application, and the passing of this case to issue, is courteously solicited. If for some reason the Examiner feels the claims are still not allowable, or wishes to discuss some change in language, a telephone interview with the undersigned attorney of record is invited.

Respectfully submitted,



D. Edward Dolgorukov
Registration No. 26,266

ATTORNEYS

Marshall & Melhorn, LLC
Four SeaGate, Eighth Floor
Toledo, OH 43604
(419) 249-7146
(419) 249-7151 (Facsimile)
Dolgorukov@marshall-melhorn.com